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Date: May 6, 2004
From: Charles T.J. Weigell Telephone: 212-541-1298
To: Supervisory Examiner Fax Number: (703) 872-9306
Long V. Le
Company: U.S. Patent and Trademark Office Telephone:
Matter 0112483 Number of Pages Including Cover: 5
Message:

In re Application of: Berend HOUWEN, et al.
Serial No. 09/388,899
Filed: September 2, 1999
For: METHOD FOR CLASSIFYING AND COUNTING LEUKOCYTES

Enclosed:

1. Response to Restriction Requirement and Summary of Conference With Supervisory Examiner Long V. Le (4 pp.)

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C010690/0112483/1151049.1

MAY 06 2004

Docket No.: C010690/0112483

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

In re Application of:
Berend HOUWEN, *et al.*

Serial No.: 09/388,899

Filed: September 2, 1999

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)
) Examiner: Gailene Gabel
)
) Art Unit: 1641
)

For: METHOD FOR CLASSIFYING AND COUNTING LEUKOCYTES

May 6, 2004

RESPONSE TO RESTRICTION REQUIREMENT AND SUMMARY OF
CONFERENCE WITH SUPERVISORY EXAMINER LONG V. LECommissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313

Sir:

This paper responds to the Office Action mailed on April 6, 2004, setting forth a one-month statutory period for response. As such, this response filed with a certificate of facsimile transmission dated May 6, 2004 is timely. 37 C.F.R. § 1.8

In the Office Action, the Examiner has required restriction of the claims pending in the application under 35 U.S.C. § 121. In so doing, the Examiner requires Applicant to select one of two groupings of claims for further prosecution. As set forth in the Office Action, Group I consists of Claims 1-4, 7-15 and 18; Group II consists of Claims 16 and 17. In requiring restriction, the Examiner considers Claims 16 and 17 to be a distinct subcombination with separate utility.

The present restriction requirement follows Applicant's submission of a Request for Continued Examination and Preliminary Amendment, filed on March 1, 2004. Previously, in the Final Office Action dated August 21, 2003, the Examiner found Claims 5 and 6, now canceled, to be allowable provided they were rewritten to avoid dependency on a rejected base claim. As such, among other amendments, the Preliminary Amendment canceled claims 5 and 6, and rewrote them as new independent Claim 16 and new claim 17. Applicant made this clear in its remarks accompanying its Preliminary Amendment.

Notwithstanding Applicant's remarks, the Examiner now requires restriction as to new Claims 16 and 17. As justification for the restriction the Examiner states:

"Inventions I and II are related as combination and subcombination...Because these inventions are distinct...and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. Literature search for each method is distinct since the structural and functional requirements of each invention are different. While searches would be expected to overlap, there is no reason to expect the searches to be coextensive."

See Restriction Action, page 3.

Applicant is at a loss to reconcile the above explanation with the new claims as submitted. As stated above, Claims 16 and 17 were prepared and submitted in response to the Examiner's prior finding that Claims 5 and 6 were allowable, provided they were rewritten to remove dependency. Claims 16 and 17 are Claims 5 and 6 so rewritten. Consequently, Applicant has canceled Claims 5 and 6.

As Claims 5 and 6 are original claims, which the Examiner has coextensively searched and examined with all other original claims, and has deemed them to be allowable, no further or additional search with respect to Claims 16 and 17 is pertinent or necessary.

In view of the above, it appears the Examiner has misapprehended the new claims presented and that the restriction requirement is improper. Immediate withdrawal of the restriction requirement is therefore solicited

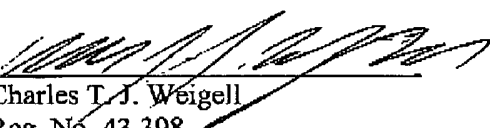
On May 5, 2004, Applicant contacted the Examiner's supervisor, Long V. Le by telephone concerning the basis for the restriction requirement. After Applicant explained its apparent improper application to claims which rewrote those previously allowed, Supervisory Examiner Le concurred that the restriction requirement should be reconsidered and withdrawn. The telephone interview concluded with Applicant agreeing to file this response, traversing the requirement while provisionally electing a group of claims. Examiner Le also agreed to check with the Examiner about the restriction requirement and seek her reasoning for issuing same.

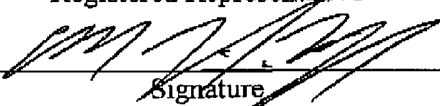
Applicant anticipates the restriction requirement will be reconsidered and withdrawn. Although Applicant strongly believes restriction to be improper, and with reference to the requirement to elect a claim group notwithstanding traversal, Applicant elects Group I for further prosecution and without prejudice as to Applicant's ability to further present, prosecute and/or gain allowance of Claims 16 and 17 in any divisional or continuation application.

CONCLUSION

For the reasons set forth above, Applicant respectfully requests the restriction requirement be withdrawn. If the Examiner has any questions regarding this paper, please contact the undersigned attorney.

By:


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